

The opinion in support of the decision being entered today  
is not binding precedent of the Board.

46  
Paper No. 59

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

WITOLD CIEPLAK  
Junior Party,  
(Application 07/542,149)

v.



MICHEL H. KLEIN, HEATHER A. BOUX,  
STEPHEN A. COCKLE, SHEENA M. LOOSMORE,  
AND GAVIN R. ZEALY  
Junior Party,  
(Application 08/070,879)

v.

MICHEL H. KLEIN, HEATHER A. BOUX,  
STEPHEN A. COCKLE, SHEENA M. LOOSMORE,  
AND GAVIN R. ZEALY  
Junior Party,  
(Patent 5,358,868),

v.

WALTER N. BURNETTE III  
Senior Party  
(Patent 5,773,600).

Patent Interference No. 104,172

ORDER TERMINATING THE INTERFERENCE

Interference No. 104,172

The record indicates that Party Klein's involved U.S. application 08/070,879, filed June 3, 1993 – has never been examined. Notwithstanding that the Notice declaring the interference (Paper No. 1) indicates that claims 25, 28-30, 33-35, 38, 39, 54-56, 64-68, 74, and 75 of Klein's application are designated to correspond to the count, their patentability has never been determined. The patentability of an application claim is a condition precedent to declaring an interference between the application and an unexpired patent. 37 C.F.R. § 1.606. Accordingly, the patentability of Klein's application claims must be determined before an interference involving Klein's U.S. application 08/070,879 and Burnette's U.S. Patent 5,773,600 can proceed.

The record also indicates that this interference improperly involves a senior party patent and a junior party patent - Burnette's U.S. Patent 5,773,600 and Klein's U.S. Patent 5,358,868. See Louis v. Okada, 57 USPQ2d 1430, 1434 (Bd. Pat. App. & Int. 2000).

The parties have been contacted about this matter. The parties have responded by recommending, in part, that Klein's involved application be returned to the examiner for prosecution.

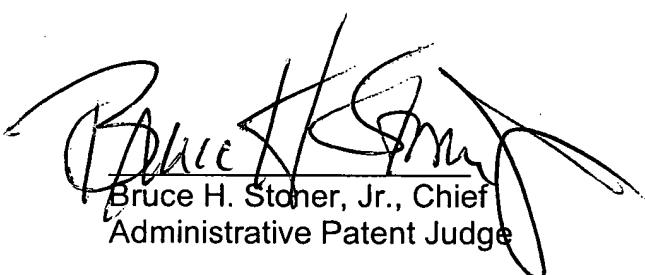
Consistent with the recommendation of the parties that Klein's involved application be returned to the examiner for prosecution, undersigned ORDERS the return of Klein's involved application 08/070,879 and instructs the examiner to examine it.

Interference No. 104,172

In order to expedite this proceeding, it is hereby ORDERED that Interference No. 104,172 be terminated without prejudice to the declaration of new interferences involving

1. Klein's Application Serial No. 08/070,879 - if the current question on the matter of the patentability of Klein's application claims is finally resolved in the affirmative, Klein's U.S. Patent 5,358,868, and Cieplak's Application Serial No. 07/542,149;
2. Klein's Application Serial No. 08/070,879 - if the current question on the matter of the patentability of Klein's application claims is finally resolved in the affirmative - and Burnette's U.S. Patent 5,773,600; and,
3. Cieplak's Application Serial No. 07/542,149 and Burnette's U.S. Patent 5,773,600.

If declared, new interferences will be conducted by the Trial Section of the Board of Patent Appeals and Interferences.



Bruce H. Stoner, Jr., Chief  
Administrative Patent Judge

Interference No. 104,172

Attorney for Cieplak:

William S. Feiler, Esq.  
Morgan & Finnegan, L.L.P.  
345 Park Avenue  
New York, NY 10154

Attorney for Klein et al.

R. Danny Huntington, Esq.  
Donna M. Meuth, Esq.  
Burns, Doane, Swecker & Mathis, L.L.P.  
P.O. Box 1404  
Alexandria, VA 22313-1404

Attorney for Burnette, III:

Michael J. Wise  
Perkins Coie LLP  
1620 26<sup>th</sup> Street  
6<sup>th</sup> Floor, South Tower  
Santa Monica, CA 90404-4013